

279,275


**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

08/279,275 07/22/94 WEINER

H 101016104US1

**EXAMINER**

ACHUTAMURTHY, P

**ART UNIT**
**PAPER NUMBER**

36

18N1/1113

 DARBY & DARBY  
805 THIRD AVE.  
NEW YORK, NY 10022

1816

**DATE MAILED:**

11/13/95

 This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

 A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input checked="" type="checkbox"/> <u>Interview Summary Record</u>            |

**Part II SUMMARY OF ACTION**

- 1.
- ☒
- Claims
- 1, 2, 9, 11-13, 15-18 and 20
- are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

- 2.
- ☒
- Claims
- 3, 4, 5, 6, 7, 8, 10, 14 and 19
- have been cancelled.

- 3.
- ☐
- Claims \_\_\_\_\_ are allowed.

- 4.
- ☒
- Claims
- 1, 2, 9, 11, 12, 13, 15, 16, 17, 18, and 20
- are rejected.

- 5.
- ☐
- Claims \_\_\_\_\_ are objected to.

- 6.
- ☐
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

- 7.
- ☐
- This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

- 8.
- ☐
- Formal drawings are required in response to this Office action.

- 9.
- ☐
- The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are
- ☐
- acceptable;
- ☐
- not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

- 10.
- ☐
- The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been
- ☐
- approved by the examiner;
- ☐
- disapproved by the examiner (see explanation).

- 11.
- ☐
- The proposed drawing correction, filed \_\_\_\_\_, has been
- ☐
- approved;
- ☐
- disapproved (see explanation).

- 12.
- ☐
- Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has
- ☐
- been received
- ☐
- not been received
- ☐
- been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

- 13.
- ☐
- Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

- 14.
- ☐
- Other

### **Part III DETAILED ACTION**

Please note the change in the examiner in charge of this application.

#### ***Specification***

The disclosure is objected to because of the following informalities: "MPB" occurs at page 19 in the legend to Table III. This abbreviation should be expanded. Appropriate correction is required.

Applicants' attention is drawn to the comments by examiner Kay K. Kim in the office action of 09/22/93, Paper No. 24, page 2, last paragraph, regarding claim 20.

#### ***Claim Rejections - 35 USC § 112***

##### **Rejection A**

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the previous office actions issued during the prosecution of the parent application serial number 07/460,852, Paper No. 24, see page 3..

Claims 1,2, 11-13, 15-18 and 20 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification, as stated above. Applicants attention is particularly drawn to the comments made on page 3 and 4 of Paper No. 24. It is again emphasized that the declaration is encouraging for the efficacy of MBP in human, but it is not sufficient to support the utility of the invention for the full scope of the claims. For example, there does not appear to be sufficient factual support for the utility of the an autoantigen for the treatment of the diseases recited in claim 2.

***Claim Rejections - 35 USC § 103***

**Rejection B**

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Serial Number: 08/279,275

Art Unit: 1816

-4-

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Evaluations of the level of ordinary skill in the art requires consideration of such factors as various prior art approaches, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, and failure of others.

The "person having ordinary skill" in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The evidence of record including the references and/or the admissions are considered to reasonably reflect this level of skill.

Claims 1, 2, 9, 11-13, 15-18 and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Campbell et al in view of Whitaker et al and/or Nalge-Anderson et al for the reasons of record in the office action of 09/22/93, Paper No. 24.

It is noted that all of the applicants' arguments in their previous responses have been fully addressed in the previous office action. Since applicants have not made any further arguments when the continuation application was filed, no further comments appear to be necessary at this time.

This has reference to the telephone interview between Seth Jacobs and examiner Kay Kim conducted on 10/24/95, wherein a preliminary amendment would be filed. Such an amendment has been filed as of the date of issuance of this action. A copy of the interview summary is attached to this action.

Serial Number: 08/279,275  
Art Unit: 1816


-5-

Note that the obviousness-type double patenting rejection over application serial number 07/596,936 is no longer maintained because this application was abandoned. However, applicants are requested to provide any information on related applications that are currently pending.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Achutamurthy whose telephone number is (703) 308-3804. The examiner can normally be reached on Monday-Thursday from 7:00 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Margaret M. Parr, can be reached on (703) 308-2454. The fax phone number for this Group is (703) 308-4065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
PONNATHAPURA ACHUTAMURTHY  
PRIMARY EXAMINER  
GROUP 1800

pa  
November 13, 1995